

## **REMARKS**

Claims 1-22 are pending in the present application. Claim 1 was amended. Reconsideration of the claims is respectfully requested.

In this Amendment, Applicant has amended claim 1 for consideration in this application. Applicant is not conceding that the subject matter encompassed by claim 1 prior to this Amendment is not patentable over the art cited by the Examiner. Claim 1 was amended in this Amendment solely to facilitate expeditious prosecution. Applicant respectfully reserves the right to pursue claims, including the subject matter encompassed by claim 1, as presented prior to this Amendment and additional claims in one or more continuing applications.

### **I. Examiner Interview**

Applicants thank Examiner Lashonda Jacobs for courtesies extended Applicants' representative on December 17, 2008. During the interview, Applicants' representative suggested claim amendments as well as pointed to differences observed between the *Helzerman* reference and the claims. Through the thoughtful insight of the Examiner, progress was made to add an appropriate limitation to claim 1. Ms. Jacobs' amendment suggestion is well received by the Applicants.

Applicants' representative discussed the specific passage used by the Examiner to allege a teaching of claim 2. Ms. Jacobs added no specific aspect of *Helzerman*, and accordingly no progress occurred at determining upon what language the Examiner based her argument concerning her allegation that *Helzerman* teaches the feature of vote weighting in claim 2. No agreement was reached.

### **II. 35 U.S.C. § 101 Patent Eligible Subject Matter.**

Claims 1-8 are rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. Applicants have amended claim 1 to recite, for example, "electronic forum determining". Such amendment is supported at least at specification page 6, lines 28-30. "A claimed process is surely patent-eligible under § 101 if: (1) it is tied to a particular machine or apparatus, or (2) it transforms a particular article into a different state or thing." *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) *en banc*.

Claim 1 now recites “electronic forum determining a readiness category for the decision maker”, therefore satisfying the prerequisites set forth in *In re Bilski*. Accordingly, Applicants urge that for at least this reason, Claim 1 includes statutory subject matter.

Claims 2-8 by virtue of their dependency on claim 1, also recite patent eligible subject matter. Accordingly, for at least the reason set forth above, claims 2-8 are statutory subject matter.

### **III. 35 U.S.C. § 103 Obviousness**

The Examiner has rejected claims 1-22 under 35 U.S.C. § 103(a) as being unpatentable over Frye et al. (Patent Publication 20010032105, hereinafter, “*Frye*”) in view of Helzerman (Patent Number 6901372, hereinafter, “*Helzerman*”).

The examiner bears the burden of establishing a *prima facie* case of obviousness based on prior art when rejecting claims under 35 in U.S.C. §103. *In re Fritch*, 972 F.2d. 1260, 23 U.S.P.Q. 2d 1780 (Fed. Cir. 1992). Rejections on obviousness grounds cannot be sustained by mere conclusory statements, instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusions of obviousness. *KSR International Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 82 USPQ2d 1385 (U.S. 2007) (citing *In re Khan*, 441 F.3d 977, 988 (Fed. Cir. 2006)). Additionally, the prior art reference (or references, when combined) must teach or suggest all the claim limitations. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974).

With respect to claim 1, the applicants have amended the claim to recite, “electronic forum determining a readiness category for the decision maker”. Accordingly, the rejection by the Examiner of claim 1 is moot. Moreover, as explained in Section II, above, because the limitation adds “electronic forum” to be the machine in this method step, the claim necessarily recites a particular machine. Accordingly a mere teaching of ‘engineers’, ‘managers’, and ‘leaders’, as *Helzerman* teaches, cannot teach a machine for performing the recited step. Rather, *Helzerman* teaches away from the claim 1 recited, “electronic forum determining”. Accordingly, Applicant has amended around *Helzerman*. It is urged that Claim 1 satisfies 35 U.S.C. § 103, and is now in a condition for allowance.

With respect to claims 9 and 16, the Examiner relies on the following passage as allegedly teaching, “determining a readiness category for the decision maker”.

Project leaders and managers next select or identify a **"lead" technology**

**group** for each identified customer need. For example and without limitation, project leaders and managers identify and/or select lead engineers and teams or individuals who will be responsible for preparing and implementing the concept proposal and project. The "output" or result of step 52 is the assignment(s) for concept proposals development.

In step 52, the preliminary concepts are received and developed. **The lead technology group (i.e., the group in charge of preparing and implementing the proposal and project)** begins by identifying the "best in class" technology (i.e., the existing product or process which clearly represents superior value to the customer, relative to all similar products or processes) and the "state-of-the-art" technology (i.e., the latest and most sophisticated or advanced stage of a technology, art or science existing at the time of manufacture). For example and without limitation, within the customer need of interest, **the lead technology group** identifies the technology currently in use for the application/need that represents superior value to the customer, relative to all similar processes. The lead technology group further determines what technologies being developed offer the greatest advantage to the company.

*Helzerman* col. 4, lines 41-64 (emphasis added).

As can be seen, Helzerman merely teaches that project leaders and managers next select or identify a 'lead' technology group for each identified customer need. The 'output' of this step is the assignment of people for concept proposals development. In contrast, claim 9 recites, "determining a readiness category for the decision maker".

In particular, claim 9 recites that the readiness category is **for** the decision maker, rather than for the project itself. Thus, actual progress of the project is not addressed in this particular claim limitation, and the readiness category is **for** the decision maker. Accordingly, for at least the reasons stated above, the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103 with respect to claims 9 and 16.

With respect to claims 2, 10 and 17, the Examiner relies on the following passage (as well as the previous passage, above) as teaching the claim 2 recited, "assigning vote weighting to the decision maker".

Referring now to FIG. 2, there is shown a method 14 for providing a skilled and competent workforce for performing a project 12. In block or step 40, people, employees or personnel, who act as the "input" for this method 14, are selected and provided by a human resources department or committee. In block or step 42, the personnel are provided with orientation and communication processes. Particularly, the selected or chosen employees are provided with general and required job orientation information. For example and without

limitation, the employees are instructed how to most effectively and/or efficiently perform their respective jobs, duties and/or responsibilities. Additionally, the employees are provided with an **ongoing communication mechanism** in which they can tender any questions, concerns or other matters regarding their employment and/or job duties, and receive prompt and accurate information in response thereto.

*Helzerman* col. 2, lines 47-63 (emphasis added).

Neither this passage, nor the col. 4, lines 41-64, passage (above) teach or suggest the claim 2 recited, “assigning vote weighting to the decision maker”. At best, *Helzerman* teaches an ongoing communication mechanism. One of ordinary skill in the art would not infer that an ongoing communication mechanism is the claim 2 recited, “assigning vote weighting”. Instead, *Helzerman* teaches a reciprocal communication mechanism that permits questions to be asked, and answers to be returned. The job orientation described by *Helzerman* could never be confused with an assignment of vote weighting in the manner claimed. Accordingly, for at least the reasons stated above, the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103.

Furthermore, the Examiner in previous office actions has advanced three (3) prior art references (*Gundewear*, *Barnard*, and *Frye*), as teaching the limitation of claim 2. (See, office action dated November 5, 2004, pp. 2 and 3; office action dated April 20, 2005, pp. 3 and 4; office action dated September 7, 2005, p. 3). Each time, Applicant has successfully argued, and the Examiner has responsively withdrawn, the allegation of the alleged prior art as teaching this claimed feature. The Examiner again, urges for a fourth time, an untenable prior art reference as teaching the feature of claim 2. The MPEP provides:

The supervisory patent examiners should impress their assistants with the fact that the shortest path to the final disposition of an application is by finding the best references on the first search and carefully applying them. The supervisory patent examiners are expected to personally check on the pendency of every application which is up for the third or subsequent Office action with a view to finally concluding its prosecution.

MPEP 707.02.

Applicants urge that the limitation of claim 2 has been thoroughly explored and found not present in the prior art. Accordingly, for at least the reasons stated above, the Examiner has not made a *prima facie* case of obviousness under 35 U.S.C. § 103. Thus, applicants urge that

claims 2, 10, and 17 be allowed.

Claims 2-8, 10-15, and 17-22 depend, respectfully on claims 1, 9, and 16. Since claims 2-8, 10-15, and 17-22 depend from claims 1, 9, and 16, the same distinctions between *Helzerman* and the claimed invention in claims 1, 9, and 16 apply to these claims. Additionally, claims 2-8, 10-15, and 17-22 claim other additional combinations of features not suggested by the reference. For example, claims 3, 11, and 18 provide for changing a graphical interface, as a function of the project assessment. Consequently, it is respectfully urged that the rejection of claims 2-8, 10-15, and 17-22 have been overcome.

#### **IV. Conclusion**

It is respectfully urged that the subject application is patentable over *Frye*, and *Helzerman* for at least the reasons stated above, and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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